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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,441	12/23/2003	Ikuo Kawauchi	Q79134	1762
23373	7590	09/23/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			LEE, SIN J	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,441

Applicant(s)

KAWAUCHI ET AL.

Examiner

Sin J. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-5 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. In view of the certified English translations of the priority documents, previous 102(e) rejection on claims 1 and 3-5 over Takamiya'036 is hereby withdrawn
2. Due to newly cited prior art, the following rejection is made non-final.

Claim Rejections - 35 USC § 103

3. Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being obvious over Endo et al (US 2003/0165775 A1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Endo teaches a presensitized plate having on an aluminum support, a thermosensitive layer containing a photothermal conversion agent (which absorbs IR rays and generates heat) and a water-insoluble and alkali-soluble resin (see abstract). Endo teaches that his thermosensitive layer can be a *superimposed thermosensitive layer composed of two layers ("the lower layer and the thermosensitive layer")* (see [0266]- [0267]). Endo teaches that both of the lower layer and the thermosensitive layer contains a water-insoluble and alkali-soluble resin and that the thermosensitive layer also contains a photothermal conversion agent that absorbs IR rays and generates heat (see [0268]). Endo states (see [0269]) that a similar compound that is used in his thermosensitive layer 1 (a thermosensitive layer composed of a single layer which is described in [0153]-[0265]) may be used as the water-insoluble, alkali-soluble high-molecular compound used for the lower layer and the thermosensitive layer. As preferable alkali-soluble high molecular compound, Endo teaches a compound containing in the molecule any functional group of (1) phenolic hydroxyl group, (2) sulfonamide group and (3) active imide group (see [0161]). Endo furthermore teaches that such high-molecular compound can be *copolymerized with another polymeric monomer* (see [0170]), which can be chosen from those exemplified in (1) to (12) (see [0174]-[0185]). The (meth)acrylic acid is included as one of those examples. Based on Endo's teaching, it would have been obvious to one of ordinary skill in the art to use a copolymer made from (i) a polymeric monomer containing any functional group of phenolic hydroxyl group, sulfonamide group or active imide group and (ii) another polymeric monomer of (meth)acrylic acid as Endo's water-insoluble and alkali-soluble

resin (to be used in both the lower layer and the thermosensitive layer) with a reasonable expectation of obtaining a presensitized plate excellent in damage resistance and sensitivity. Such copolymer made from the (meth)acrylic acid monomer would contain present monomer unit of formula (A) of claim 1 (since n can be 0). Therefore, Endo's teaching renders obvious present inventions of claims 1 and 3-5.

Allowable Subject Matter

4. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Endo does not teach or suggest present copolymer including the monomer unit represented by formula (A').

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333. The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Lee

S. Lee
September 17, 2005

Sin Lee

**SIN LEE
PRIMARY EXAMINER**